5/10/02

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Paper No. 11
GDH/gdh

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Endonetics, Inc.

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Serial No. 75/605,751

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Tirzah Abé Lowe of Knobbe, Martens, Olson & Bear, LLP for Endonetics, Inc.

Megan Sweeney, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

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Before Hohein, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Endonetics, Inc., by change of name from Akos Biomedical, Inc., has filed an application to register the mark "ENDONETICS" for "diagnostic and therapeutic medical devices for the treatment of gastrointestinal disease."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground

[1] Ser. No. 75/605,751, filed on December 15, 1998, which is based on an allegation of a bona fide intention to use the mark in commerce.

that applicant's mark, when used in connection with its goods, so resembles the mark "ENDONET," which is registered for a "computer system, namely, [a] video processor, computer peripherals and multiple task server unit for use in medical applications,"[2] as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed,[3] but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.[4]

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[2] Reg. No. 1,688,321, issued on May 19, 1992, which sets forth a date of first use anywhere and first use in commerce of October 22, 1991; combined affidavit §§8 and 15.

[3] Applicant's request for an extension of time to file its reply brief is granted.

[4] The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Turning first, therefore, to consideration of the respective goods, it is well established, as pointed out by the Examining Attorney in her brief, that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Applicant maintains, however, that the respective goods and channels of trade therefor are too dissimilar to give rise to a likelihood of confusion. Specifically, applicant asserts in its initial brief that, as to the dissimilarities between the goods at issue:

> Registrant's computer system is made up of a server, i.e., a networked computer, computer peripherals (usually a computer keyboard and mouse), and a video processor. A video processor is generally either a separate unit, or a board with the server that fine tunes video images. A monitor is

> implied in the system since a video processor is typically in communication with a monitor. Applicant has reviewed Registrant's web site, located at www.pentaxmedical.com. Although Applicant did not find use of the specific ENDONET mark by Registrant, the computer systems and video processor products described on the web site are used to schedule medical appointments and record visual medical data. Although Registrant's computer system has medical applications, Registrant's goods are primarily computers, not medical devices.
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> In contrast, Applicant's goods are sophisticated medical devices that are implanted into a patient's stomach. In a very specialized procedure, doctors pin Applicant's device into the lining of the patient's stomach near the upper valve. Once the device is implanted, it measures the acidity levels in the patient's stomach. This information can be used to help diagnose and treat gastrointestinal diseases such as Gastrointestinal Reflux Disease (GIRD). The device usually remains in the patient for several days. Applicant respectfully notes that the device does not record any visual information.

Thus, according to applicant, registrant's "computer system composed of a video processor, computer peripherals and a server is significantly different from a sophisticated medical device that is implanted into a person's stomach," which is the case with applicant's "diagnostic and therapeutic medical devices for the treatment of gastrointestinal disease."

With respect to the channels of trade for the goods at issue and the purchasers thereof, applicant contends in its initial brief that:

> Applicant targets a very different type of buyer than Registrant. Applicant targets highly trained medical personnel, who are very familiar with specialized gastrointestinal procedures and treatments for patients. Applicant's consumers are doctors known as "gastroenterologists." These are highly specialized medical professionals that diagnose and treat gastrointestinal diseases. .... Registrant's consumers are most likely medical technicians who use computer systems. Such medical technicians are probably trained in database management or computer networking and need not be familiar with the very specific field of gastrointestinal procedures. Because the goods are marketed to different customer bases, no customer confusion would occur ....

Applicant also insists that, "[e]ven if Registrant and Applicant conduct their business in the same medical field of endoscopic gastroenterology and sell their products to the same hospital, this would not diminish the dissimilarity in trade channels because," citing Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983), and In re Digirad Corp., 45 USPQ2d 1841 (TTAB 1998), "courts have held that a hospital is not a relevant purchaser because it is composed of separate departments with diverse purchasing requirements, which in effect, constitute different markets for the parties' respective goods."

In addition, applicant urges that not only are the respective goods expensive, the purchasers thereof "are highly

sophisticated and extensively trained in their field." The decision to purchase the goods at issue, applicant argues, requires the exercise of a great deal of time and effort. Given the need for such care and deliberation in the purchasing process, applicant maintains that confusion as to source or sponsorship is unlikely to occur.

We are constrained to agree with the Examining Attorney, however, that the respective goods are so closely related that, if sold under the same or substantially similar marks, confusion as to the origin or affiliation thereof is likely, notwithstanding the level of purchaser sophistication. As the Examining Attorney persuasively notes in her brief:

> The goods ... are highly related. Based on the respective identifications of goods, the goods are both used in the medical industry. There are no restrictions placed on the type of medical applications for which the registrant's goods were designed. There is no evidence to suggest that gastroenterologists or their staff do not use both the registrant's goods and the applicant's goods. .... The applicant's identification of goods, which the applicant declined to amend, [is broadly set forth as] "diagnostic and therapeutic medical devices for the treatment of gastrointestinal disease" [and thus] does not specify in any way the type[s] of devices involved. The applicant does not provide any evidence to show that its devices do not include gastrointestinal endoscopes or that its devices are not used in conjunction with the registrant's goods.

> Furthermore, the examining attorney has submitted actual evidence of the overlap in trade channels. The evidence attached to the final Office action shows that the registrant's goods are used in endoscopic procedures, which could include gastrointestinal endoscopy. The evidence from the final Office action also shows that the applicant's goods are used with respect to gastrointestinal endoscopy.

Consequently, because "[t]he applicant's goods and the registrant's goods can be used for the same purpose, namely, to gather information in order to diagnose and/or treat the patient's gastrointestinal disease," the Examining Attorney concludes that such goods are closely related and that the channels of trade therefor and purchasers thereof would be the same.

The evidence made of record and referred to by the Examining Attorney as supporting her position consists of printouts from both registrant's and applicant's websites as well as various dictionary definitions which serve to explain the nature and use of registrant's video processors and applicant's medical devices. In particular, the pages from registrant's website, which discuss the features of its "EPM-3300 Video Processor,"[5] indicate that such product "is the control center of the Pentax Video Endoscope system; that it

[5] While there is apparently no mention of the specific video processor used as part of registrant's "ENDONET" computer system, such excerpt would appear to be indicative of the general nature and function of the video processors offered by registrant.

"provides extremely high resolution images with excellent color reproduction"; that "[m]ost Pentax endoscopes, video and fiber, can be connected to the EPM-3300"; and that it "can be configured to control many documentation devices," with "[e]xpanded image and patient data management ... accomplished [by] using computerized systems: IMS-3000 or EndoNet." Definitions from the On-line Medical Dictionary define "endoscopy" as, in general, "[t]he visual inspection of any cavity of the body by means of an endoscope" and "endoscopy, gastrointestinal" as, in particular, the "visual examination of the gastrointestinal tract by means of a fiberoptic endoscope. It is used to localise [sic], identify, and photograph pathologic alterations, to obtain biopsy material and perform other surgical interventions, and for delivery of medication." "Endoscope," according to the excerpt from The American Heritage Dictionary of the English Language, is defined as "[a]n instrument for examining visually the interior of a bodily canal or a hollow organ such as the colon, bladder, or stomach." The pages from applicant's website indicate that, like registrant and the applications for the endoscopic video processors it markets, applicant is a "company focused on the development of endoscopic devices for Gastroesophageal Reflux Disease (GERD)." Specifically, such pages state that applicant "is developing two proprietary endoscopic technologies, one diagnostic ... and one

therapeutic ... that will have a significant impact on the gastroenterologist's ability to manage patients with GERD."

It is well settled that that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Here, not only are registrant's and applicant's goods so broadly identified as to encompass, on the one hand, medical computer systems, including video processors, for use in the treatment of gastrointestinal disease and, on the other hand, diagnostic and therapeutic medical devices for the treatment of gastrointestinal disease, but the evidence of record indicates that such closely related goods are in fact specifically designed for use by gastroenterologists in conducting gastrointestinal endoscopic procedures. Such goods, therefore, would travel in the same channels of trade and be purchased and used by the same medical specialists.

Furthermore, while it is obvious from the inherent expense and sophistication of the respective goods that the purchasers thereof would be expected to exercise a high degree of care or discrimination in the selection of such goods, it is

still the case that the fact that gastroenterologists, for example, exercise deliberation in choosing the respective products "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

This brings us to consideration of the marks at issue. Applicant argues that, when considered in their entireties, its mark "ENDONETICS" and registrant's mark "ENDONET" are "very dissimilar in their appearance." In particular, applicant contends--notably without supporting evidence--that the mere fact that the marks share "the similar prefix 'ENDO'" (actually, the shared prefix is identical rather than "similar") "is not enough to give rise to a likelihood of confusion because the term 'ENDO' is commonly used in the medical industry."[6] The

[6] Although applicant asserts, in its initial brief, that "many registered trademarks exist that begin with 'ENDO' and ... are used in connection with medical goods and services," applicant cites as examples only "U.S. Registration Nos. 2,361,268, 1,854,089 and 1,994,421 for the marks ENDOCLAMP, ENDOPLUS and ENDOTHERM" as being "used in connection with medical devices or services." The Board, however, does not take judicial notice of third-party registrations. See, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). Moreover, even if applicant had supported its argument with copies of the third-party registrations upon which it purports to rely, such would not in any event constitute proof of actual use of the

distinguishing features of the marks at issue, applicant consequently insists, "are the letters at the end of each mark," with the suffix "NET" in registrant's mark being "visually dissimilar" from the suffix "ICS" in applicant's mark. Likewise, as to differences in pronunciation of the respective marks, applicant asserts that "a consumer viewing or articulating the trademarks in their entireties would not confuse Applicant's mark for Registrant's mark" because "[t]he differences in the number of letters and syllables, as well as the distinguishing sounds of 'NET' and 'ICS,' would not lead the consumer to erroneously purchase Registrant's [ENDONET] computer system although actually desiring to purchase an ENDONETICS medical device for the treatment of gastrointestinal disease."[7]

In addition, applicant maintains that confusion is not likely inasmuch as the respective marks are entirely different

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registered marks and that the purchasing public, having become conditioned to encountering certain products and service under marks which consist of or include the prefix "ENDO," is therefore able to distinguish the source thereof based upon differences in such marks. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). Thus, the number and nature of similar marks in use on similar goods and/or services is not a relevant *du Pont* factor in this appeal.

[7] Such argument, as set forth by applicant, fails to recognize that, as correctly noted by the Examining Attorney in her brief, "[t]he issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. See, e.g., In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984) ["the question to be determined herein is not whether the goods are likely to be confused but rather whether there is a likelihood of confusion as to the source of the goods because of the marks used thereon"] and TMEP Section 1207.01.

in connotation and commercial impression. Specifically, applicant contends that:

> [T]he last syllable "NET" of Registrant's mark connotes a relation to networks and computers. This is due to the fact that "NET" is a common abbreviation for "network" or "computer network." The last syllable of Applicant's mark, however, connotes something entirely different from a computer network. The suffix "ICS" means "qualities, properties." Webster's New World College Dictionary 4th Ed. (1999). The addition of "NETICS" to the prefix "ENDO" all but strips "endonetics" of any connotation to computer networks. Rather, the suffix "NETICS" is more commonly found in words defining certain practices and fields of study, such as "kinetics," the dynamics of energy[,] and "dianetics," the dynamics of mental health. Here, the term "endonetics" suggests the dynamics of endoscopy, which is the practice of examining visually the inside of an organ. Webster's New World College Dictionary 4th Ed. (1999). Thus, Applicant's mark and Registrant's mark have different connotations and make different commercial impressions upon the consumer.

We concur with the Examining Attorney, however, that the marks at issue do not merely share the term "ENDO." Rather, they have in common the term "ENDONET" which, as the Examining Attorney points out in her brief, "is not only the registrant's entire mark, it is also the root of the applicant's mark." As the Examining Attorney further notes in her brief, the record demonstrates that:

> The "-ICS" portion of the applicant's mark is merely a suffix which means "**1.** Science; art; study; knowledge; skill: *graphics*. **2.** Actions, activities, or practices of: *athletics*. **3.** Qualities or operations of: *mechanics*." *See The American Heritage Dictionary of the English Language* (3rd ed. 1992).

In view thereof, we essentially agree with the Examining Attorney that, in effect, the mere addition of the suffix "-ICS" to registrant's mark "ENDONET" so as to form applicant's mark "ENDONETICS" is insufficient to result in a significant difference in either the overall connotation or commercial impression engendered by applicant's mark vis-à-vis registrant's mark. Both marks, instead, are highly similar in the connotation and commercial impression which they project, such that even if registrant's mark is considered suggestive of a computer network which pertains to endoscopic practices or procedures, applicant's mark is similarly suggestive of endoscopic practices or procedures.

Moreover, as the Examining Attorney additionally notes in her brief:

> Since the marks are based on the same root, they also share similarities in appearance and sound. It is reasonable that, one would hear or read the root "ENDONET," the whole of the registrant's mark, in order to hear or read "ENDONETICS," the applicant's mark.

Given that applicant has, in essence, appropriated the entirety of registrant's mark, with the latter constituting the initial

and major part of the former inasmuch as the short suffix "-ICS" adds little of trademark significance to distinguish applicant's mark, we find that the respective marks on the whole are substantially similar in sound, appearance, connotation and commercial impression.

Accordingly, we conclude that such medical personnel as, principally, gastroenterologists and others involved in the diagnosis and treatment of gastrointestinal disease, who would be familiar or acquainted with registrant's "ENDONET" mark for its "computer system, namely, [a] video processor, computer peripherals and multiple task server unit for use in medical applications," would be likely to believe, upon encountering applicant's substantially similar "ENDONETICS" mark for its "diagnostic and therapeutic medical devices for the treatment of gastrointestinal disease," that such closely related goods emanate from, or are sponsored by or associated with, the same source. See, e.g., United States Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co., 224 USPQ 497, 498 (TTAB 1984) [in finding mark "OLYMP" for shirts, blouses and collars likely to cause confusion with mark "OLYMPIC" for warm-up uniforms used in connection with track and field games, helmets, and track shoes, board noted that "marks with 'small suffix' add-on differences comparable to 'OLYMP' and 'OLYMPIC' have not infrequently been found to produce a likelihood of confusion or

mistake when used on similar goods"]; In re Pellerin Milnor Corp., supra at 559 [mark "MILTRON" for a "microprocessor for controlling and programming the operation of a commercial laundry washing and drying machine and sold as part thereof" held likely to cause confusion with mark "MILLTRONICS" (in stylized format) for "electronic control devices for automatically regulating or controlling the operation of machinery"]; and Sun Electric Corp. v. Sun Oil Co. of Pennsylvania, 196 USPQ 450, 453 (TTAB 1977) [mark "SUNELECT" for "electrical transformer oils" found likely to cause confusion with trade name "Sun Electric" for company which manufactures "electrically operated testing and indicating instruments"].

**Decision**: The refusal under Section 2(d) is affirmed.